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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/766,798 | 01/28/2004 | Paul C. Probst | PROB100USA | 3999 |
| 24339 | 7590 | 08/25/2006 | EXAMINER | |
| JOEL D. SKINNER, JR. SKINNER AND ASSOCIATES 212 COMMERCIAL ST. HUDSON, WI 54016 | | | EDELL, JOSEPH F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3636 | |

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/766,798 | Applicant(s) PROBST, PAUL C. | |
| | Examiner Joseph F. Edell | Art Unit 3636 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 10 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 10 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 June 2006 has been entered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: shell 12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1 and 24 objected to because of the following informalities:

- a. claim 1, line 13, "source" should read --source.--;
- b. claim 24, line 16, "source" should read --source.--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 4, 10, and 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to independent claims 1 and 24, the motor mechanism is recited as being "connected to the tube tunnel." However, the specification only teaches that the motor mechanism is housed with the tube and is not taught as being connected to the tube tunnel. Therefore, the specification fails to convey to one skill in the art that Applicant, at the time the application was filed, had possession of the claimed invention. In addition, the specification does not teach the orientation of the bicycle seat in relation to a bicycle frame. Therefore, the specification fails to convey to one ordinary skill that Applicant, at

the time the application was filed, has possession of a bicycle seat with a long axis substantially parallel to the plane of the frame and wheels of the bicycle.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 10, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2004/0021347 A1 to Turudich in view of U.S. Patent No. 4,613,187 to Gordon.

Turudich discloses a seat that is basically the same as that recited in claims 1, 4, 10, and 20-24 except that the seat lacks a tube, as recited in the claims. See Figures 1-4 of Turudich for the teaching that the seat has a shell 13 (see Fig. 2), spaced apart rods 18,19, an electric vibratory motor mechanism 11, a power source 25 connected to the motor mechanism, and a control 26 connected to the motor mechanism and power source wherein the motor vibrates at frequencies above 3000 RPM and the seat is made of composites and the motor mechanism and power source extend along a long axis of the seat. Gordon discloses a tube 11 (Fig. 3) within a tube tunnel 12 and housing a battery, and light 173. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seat shell such that it includes a tube tunnel molded in the seat shell for housing a tube with the motor

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mechanism and power source, extending along the long axis of the seat, and having contact points with the seat rods, such as the seat disclosed in Gordon. One would have been motivated to make such a modification in view of the suggestion in Gordon that tube housing provides a housing for the batteries used in conjunction with a powered object in the seat.

Although the tapering tube shape of claims 22 is not specifically taught in Turudich in view of Gordon, it would have been an obvious matter of design choice to make the specific thicknesses since such a modification would have involve a mere change in size of the tube. A change in size is generally recognized as being within the level of ordinary skill in the art.

Although the frequency of claim 23 is not specifically recited, modifying the frequency would have been obvious at the time of Applicant's invention because the use of optimum workable ranges discovered by routine experimentation is ordinarily within the skill of the art. Further, it would have been an obvious matter of design choice to modify to lower the frequency by 200 RPM since the Applicant has not disclosed that having the specific frequency solves any stated problem or is for any particular purpose and it appears that the motor would perform equally well with an well known frequency used in the art.

Response to Amendment

8. The declaration filed on 16 June 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Turudich reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Turudich reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). With respect to the evidence submitted showing the underside of a bicycle seat, critical claimed features are not demonstrated. The features not demonstrated include: (1) a tube tunnel for disposing the tube, (2) a vibratory, oscillating motor mechanism disposed within the tube, and (3) a control connected to the motor mechanism and power source.

Response to Arguments

9. Applicant's arguments filed 16 June 2006 have been fully considered but they are not persuasive. Applicant argues that there is no motivation to combine the teachings of Turudich in view of Gordon. While Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, Gordon provides the necessary motivation that using a tube tunnel is a generally known structural feature to house batteries and control mechanism within a bicycle seat construction. In response to Applicant's argument that Turudich

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and Gordon do not teach a tube tunnel planar orientation with respect to the bicycle frame, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Edell whose telephone number is (571) 272-6858. The examiner can normally be reached on Mon.-Fri. 8:30am-5:00pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Joe Edell', is written over a horizontal line.

Joe Edell
August 21, 2006